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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,346	03/01/2004	Justin Wade Snowden		9056
45352	7590	01/10/2006	EXAMINER	
THE INVENTORS NETWORK, INC. 332 ACADEMY STREET CARNEGIE, PA 15106			BONK, TERESA	
		ART UNIT	PAPER NUMBER	
		3725		
DATE MAILED: 01/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

SJP

Office Action Summary	Application No.	Applicant(s)
	10/789,346	SNOWDEN, JUSTIN WADE
	Examiner	Art Unit
	Teresa M. Bonk	3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 15 and 16 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 15 and 16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 November 2005 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indication of all allowable subject matter in paragraphs 10 and 11 of the Office Action dated August 1, 2005, is withdrawn.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is no clear enabling disclosure for a selectively movable depth slider switch such that one of ordinary skill in the art could make and/or use the claimed invention without undue experimentation analysis. Applicant's remarks have been noted, but are not persuasive. The description in the substitute specification, on page 8, lines 9-14, is merely a generalized functional statement, but does not enable one skilled in the art to make and/or use the invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kermnitz et al. (US Patent 4,495,791) in view of Chartier (US Patent 3,030,837). Kermnitz et al. discloses a “dent removing pneumatic puller” (title) having an elongated housing (structural housing 13) having a nose end (front cap 30) and enclosed therein a pneumatic hammer (pneumatic motor means 40), a handle (90/70) attached to the housing; means for interconnecting the housing to a pressurized flow of air (gas connection 55); a threaded member securable to the nose end of the housing and capable of insertion into a hole formed on the surface of the dented part (a hardened tool steel point 21 with threads 22, see Figure 1, and column 5, lines 10-15); and a manually operable trigger on the handle (valve piece 64 of the piston control means 62, column 5, line 5) capable of being manually squeezed by a technician and the technician applying a pulling force on the handle thereby actuating the pneumatic hammer to act in the direction opposite of the

threaded member so that the dented part can be pulled out to its original position by the threaded member (Column 4, lines 57-68 and Column 5, lines 1-31).

5. Kemnitz et al. discloses the invention substantially except for the threaded member being replaceable, a u-shaped tool including a threaded stud for attachment to the threaded member to be hooked onto the dented part, and a right-angled tool for attachment to the threaded member to be hooked onto the dented part.

6. Chartier discloses a dent-removing tool with the threaded members being replaceable (metal-engaging members, Column 1, lines 41-42). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to manufacture the pneumatic puller of Kemnitz et al. with replaceable threaded members in view of the teachings of Chartier to allow for quick and easy handling for the removal of dents with minimum body effort and to provide a tool that is effective in operation and long wearing in use and “to permit easy replacement of the working parts” (Chartier, column 1, lines 42-43).

7. Chartier also teaches a u-shaped tool including a first threaded stud for attachment to the threaded member to be hooked onto the dented part (Figure 4) and a right-angled tool for attachment to the threaded member to be hooked onto the dented part (Figure 5). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include a u-shaped and a right-angled tool for attachment to the threaded member to make it possible for the operator to access and repair dents in door panels, fenders, etc. that are often enclosed “and further provide a versatile tool adaptable for use in various types of body work” (Chartier, column 1, lines 43-45).

Response to Arguments

8. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa M. Bonk whose telephone number is (571) 272-1901. The examiner can normally be reached on M-F 7:30AM - 5PM with alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-9900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Teresa M. Bonk
Examiner
Art Unit 3725



DERRIS H. BANKS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700